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Amendment
Attorney Docket No. B94.2R-11442-US01

Remarks

This Amendment is in response to the Office Action dated **December 23, 2004**. Claims 1-20 are pending in this application. Claims 15-20 have been withdrawn. The Office Action rejects claims 1-7 and 9-11 under 35 USC § 102 as being anticipated by Robinson et al. (US 6,484,430; hereinafter "Robinson"); rejects claims 1-7 and 9-11 under 35 USC § 102 as being anticipated by Olson (US 6,609,319); rejects claims 12-14 under 35 USC § 102 as being anticipated by Knight et al. (US 6,189,253; hereinafter "Knight"); and rejects claim 8 under 35 USC § 103 as being obvious over Robinson in view of Knight.

By this Amendment, claims 1, 3, 12 and 13 are amended and claims 21-24 are added. Applicant reserves the right to prosecute all cancelled subject matter in a subsequent patent application claiming priority to the immediate application. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Restriction Requirement

Applicant affirms the election of Group I of the restriction, and claims 1-14.

Interview Acknowledgement

Applicant's undersigned representative spoke with Examiner Semunegus on March 17, 2005. However, a substantive interview to discuss the claims was not arranged. Examiner Semunegus is invited to contact Applicant's undersigned representative if the arguments presented herein are not persuasive.

Claim Rejections – Claims 1-7 and 9-11

The Office Action rejects, under 35 USC § 102, claims 1-7 and 9-11 over Robinson, and claims 1-7 and 9-11 over Olson. These rejections are traversed as discussed below. Further, Applicant has amended claim 1 for clarification purposes.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference" (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicant asserts that neither Robinson nor Olson disclose or suggest a gun action

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assembly including "an action rod fixedly attached to said receiver" as recited in independent claim 1 as originally filed. Neither reference discloses an action rod which is capable of "preventing rotation of the bolt when the cam pin is engaged with the action rod" as recited in claim 1 as filed.

Robinson discloses a bolt carrier 100 having a cam slot 202 and a bolt 101 having a cam pin 301. Robinson also discloses a firing pin 305. See Figure 4 and column 2, lines 54-67. The Examiner has read Applicant's claimed "action rod" onto the Robinson firing pin 305 and argues that the firing pin 305 is inherently fixedly attached to a receiver and that the firing pin 305 prevents rotation of the bolt 101 when the cam pin 301 is engaged with the firing pin 305.

Applicant asserts that the Robinson firing pin 305 is not fixedly attached to a receiver as argued by the Examiner. The firing pin 305 is held within the bolt carrier 100 by a carrier end pin 304. See Figure 4 and column 2, line 65-column 3, line 3. A person of ordinary skill in the art would understand that the bolt carrier 101 would reciprocate within a receiver, and that the firing pin 305 would reciprocate with the bolt carrier 101. Therefore, the firing pin 305 is not fixedly attached to a receiver as required by claim 1.

Applicant further asserts that the firing pin 305 does not prevent rotation of the bolt 101. The firing pin 305 passes through the bolt 101 and through an aperture in the cam pin 301. A person of ordinary skill in the art would understand that the firing pin 305 does not directly cause the bolt 101 to rotate or directly prevent the bolt 101 from rotating. The firing pin 305 simply holds the cam pin 301 in place within the bolt 101. Rotation of the bolt 101 in the Robinson device is dictated by the position of the cam pin 301 within the cam slot 202. As the bolt 101 moves within the bolt carrier 100 and the cam pin 301 travels the length of the cam slot 202, the cam pin 301 abuts the edge of the cam slot 202 and forces rotation of the bolt 101. While not described in detail, this operation is disclosed at column 2, lines 58-60. Because the bolt 101 and cam pin 301 are free to rotate about the firing pin 305, the firing pin 305 does not prevent rotation of the bolt as required by claim 1.

Applicant further asserts that Robinson does not disclose a receiver. The Examiner points to column 2, lines 43-44 for the disclosure of a receiver. However, this passage teaches that the bolt carrier 100 may fit a wide variety of ammunition magazines. Robinson does

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not show a receiver in the Figures or discuss a receiver in the description.

Therefore, Applicant asserts that claim 1 is not anticipated by Robinson.

Similarly, Olson discloses a bolt 4, a cam pin 10 and a firing pin 12. See Figure 1 and column 4, lines 20-27. The figures of Olson do not show a receiver or a bolt carrier. The Examiner has read Applicant's claimed "action rod" onto the Olson firing pin 12 and argues that the firing pin 12 is inherently fixedly attached to a receiver and that the firing pin 12 prevents rotation of the bolt 4 when the cam pin 10 is engaged with the firing pin 12.

Applicant reasserts the arguments made above with respect to Robinson. The Olson firing pin 12 is not fixedly attached to a receiver because the firing pin 12 must reciprocate within a receiver. Therefore, the firing pin 12 is not fixedly attached to a receiver as required by claim 1.

The firing pin 12 does not prevent rotation of the bolt 4, as the bolt 4 and cam pin 10 are free to rotate about the firing pin 12. The interaction of the cam pin 10 and a bolt carrier would cause and/or prevent rotation of the bolt 4.

Therefore, Applicant asserts that claim 1 is not anticipated by Olson.

Further, Applicant has amended claim 1 for clarification purposes. These changes have been made for reasons unrelated to patentability and are not intended to disclaim any patent scope. See *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 43 USPQ2d 1152, 1154 (Fed. Cir. 1997). Support for the amendments to claim 1 may be found at least in Figures 10 and 10a.

Amended claim 1 requires the longitudinal axis of the bolt to be offset from the longitudinal axis of the action rod. This amendment further distinguishes over both Robinson and Olson, in which the firing pin is positioned concentrically within the bolt, and the longitudinal axis of the firing pin and the longitudinal axis of the bolt share a common line.

For the reasons asserted above, Applicant submits that amended claim 1 is not anticipated by Robinson or Olson. Claims 2-7 and 9-11 depend from claim 1 and are not anticipated for at least the reasons discussed with respect to claim 1. Accordingly, Applicant requests withdrawal of the rejections of claims 1-7 and 9-11 under 35 USC § 102.

Claim Rejections – Claims 12-14

The Office Action rejects, under 35 USC § 102, claims 12-14 over Knight. These

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rejections are traversed. Applicant has also amended claim 12 for clarification purposes.

Applicant asserts that Knight does not disclose or suggest a gun action assembly including "a receiver having a cartridge ejection port" and "a bolt-carrier having a charging handle" with "the charging handle extending through the cartridge ejection port" wherein "the charging handle prevents rotation of the bolt-carrier within the receiver," as recited in independent claim 12.

Knight discloses a muzzle loading rifle with a bolt-type action for loading the propellant. Unlike Applicant's gas operated action which automatically ejects a spent bullet cartridge casing using high-pressure propellant gas and automatically chambers a new round, the Knight rifle relies on manual operation of the bolt assembly and manual loading of the propellant and a new round to achieve reloading.

The Knight rifle does not utilize typical cartridge bullets, which generally include the bullet, a propellant and a metal jacket or casing which contains the propellant behind the bullet. A bullet is loaded into the Knight rifle through the muzzle or front end of the gun. The propellant is separately loaded into a different portion of the gun via the breech opening near the rear of the gun. The propellant may be in the form of a percussion cap or a shot gun primer. See column 1, lines 16-64, especially lines 46-54.

The Examiner has asserted that Knight discloses an ejection port 70 and a charging handle 72. See Figure 9 and paragraph 5 of the Office Action. Applicant asserts that this characterization of the Knight device is incorrect. Knight discloses a cocking piece 64 having a laterally extending aperture 70. A pin 72 extends through the laterally extending aperture 70 and also through an aperture 54 of the striker pin 56. This pin 72 secures the striker pin 56 to the cocking piece 64. See Figures 9-10 and column 3, lines 33-41.

Applicant asserts that a person of ordinary skill in the art would understand that the claimed ejection port is an aperture through which a spent bullet cartridge case may be ejected. See, for example, Figures 11b and 12b of the Application, which show a cartridge case 82 being ejected through the ejection port 26. See also the specification page 19, lines 16-26 for a discussion of such operation. Applicant has amended claim 12 to further clarify that the ejection port is a "cartridge ejection port". This amendment is made for reasons unrelated to patentability and is not intended to disclaim any patent scope.

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Applicant asserts that the Knight laterally extending aperture 70 is not capable of functioning as an ejection port as submitted by the Examiner.

Knight does disclose a receiver 14 having a breech opening 16. See Figure 1 and column 2, lines 60-63. A person of ordinary skill in the art would understand that in a typical bolt action rifle which uses cartridge bullets, a spent bullet cartridge casing may pass through the breech opening when being manually ejected from the rifle. Therefore, if Applicant's claimed "receiver having an ejection port" is read onto the Knight rifle, the only portion of the rifle that could function as an ejection port is the breech opening 16. However, because the Knight device does not use cartridge bullets, there is no empty cartridge case to eject. Knight simply does not disclose or suggest an ejection port because the Knight rifle does not require an ejection port.

Applicant further asserts that a person of ordinary skill in the art would understand that the claimed "charging handle" may be used to manually actuate a bolt carrier. The pin 72 of the Knight rifle is not capable of functioning as a charging handle as submitted by the Examiner. Knight discloses a bolt assembly 22 which includes a bolt handle 40. The bolt handle 40 may be used to rotate the sleeve portion 24 of the bolt assembly 22. See column 3, line 1 and column 4, lines 27-45. Therefore, if Applicant's claimed "charging handle" is read onto the Knight rifle, the portion of the rifle that could function as a charging handle is the bolt handle 40. However, even with this characterization, the Knight rifle fails to meet the claimed limitation that the charging handle extends through the ejection port.

Further, claim 12 requires that "the charging handle prevents rotation of the bolt-carrier within the receiver." The bolt handle 40 of the Knight rifle is used to rotate the bolt assembly 22, and therefore, the bolt handle 40 does not prevent rotation of the bolt assembly 22.

Therefore, Applicant asserts that independent claim 12 is not anticipated by Knight. Claims 13 and 14 depend from claim 12 and are not anticipated for at least the reasons discussed with respect to claim 12. Accordingly, Applicant requests the withdrawal of the rejection of claims 12-14 under 35 USC § 102.

Claim Rejections – Claim 8

The Office Action rejects, under 35 USC § 103, claim 8 over Robinson in view of Knight. This rejection is traversed.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings to produce the claimed invention. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

The Office Action admits that Robinson does not teach a charging handle which passes through an ejection port, and asserts that the addition of Knight renders claim 8 obvious.

As discussed above with respect to claims 12-14, Applicant asserts that Knight does not disclose or suggest an ejection port because there is no cartridge case to eject. Applicant further asserts that the pin 72, argued by the Examiner to be a charging handle, is not capable of functioning as a charging handle.

Applicant further asserts that Robinson and Knight are not properly combinable. Robinson discloses a bolt carrier for use with a gun having a gas operated action, similar to Applicant's gas operated action. Such guns automatically reload and are capable of firing many shots in a short period of time. Knight discloses a muzzle loading rifle with a bolt action for loading the propellant manually. Both the bullet and the propellant in the Knight rifle must be manually reloaded after each shot. A person of ordinary skill in the art would understand that the components of these two different mechanisms are not readily combinable, and that there would be no reasonable expectation of success in combining the mechanisms. Incorporating portions of the Knight device into the Robinson device would render a gun that is inferior to the embodiment disclosed in Robinson.

The Examiner has provided no prior art motivation to modify Robinson according to the Knight device. Even if the Knight receiver could be used with the Robinson invention as asserted by the Examiner, there is nothing in the applied references that would motivate a person to make such a substitution.

Further, as asserted above in the discussion of claims 1-7 and 9-11, claim 1

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includes limitations other than the charging handle and ejection port which Robinson fails to disclose or suggest. Claim 8 depends from claim 1 and includes all of the limitations of claim 1.

Thus, Robinson and Knight do not teach all of the limitations of claim 8; there is absolutely no prior art motivation to combine or modify the references; and there is no reasonable expectation that combining features of the Robinson and Knight devices would result in a successful device. Therefore, Applicant asserts that claim 8 is not obvious over Robinson in view of Knight. Accordingly, Applicant requests withdrawal of the rejection under 35 USC § 103.

Conclusion

Based on at least the foregoing amendments and remarks, Applicant respectfully submits this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-14 and 21-24 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: March 18, 2005

By: _____

Jeremy G. Laabs

Registration No.: 53170

6109 Blue Circle Drive, Suite 2000
Minnetonka, MN 55343-9185
Telephone: (952) 563-3000
Facsimile: (952) 563-3001

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